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Minoru Yoshida

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EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

PALO, FRANCIS T

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 4/9/08 have been fully considered but they are not persuasive.

Applicant submits:

Furusawa shows a two-level greening structure including a plant-cultivable planting portion (8) on a water-reserving portion (7), but without the support post-shaped members claimed in the instant application.

Yoshida et al. discloses a plant cultivation mat to be spread over artificial ground, which permit walkers to tread on the soil filled in the mat as well as the plant grown in it. The plant cultivation mat comprises a cell disposed in a recessed form with the top part thereof being open upward and with a water-passage port being perforated in the vicinity of the bottom part thereof; and pillar members (6) erected within the cell to a height not exceeding the upper end part of the lateral wall of the cell.

Furukawa discloses a structured body for drainage treatment which is an unit box composed of a top panel having multiple weep holes and downward cylinders (117) provided therein and side walls having multiple weep holes and joints for connection, which can be spread to a desired size by connecting these unit boxes. The structured body for drainage treatment can be used as a material for drainage of sports grounds, roads, parks, golf links, stockhouses, riding grounds and the like, as an antifreezing material for roads in cold districts, and as a material for preparing tree-planting ground in the concrete portion on the roof, desert areas and the like.

Thus, if the structure disclosed in Yoshida et al. corresponds to planting portion (200 in FIG. 1(a)) and the structure disclosed in Furukawa corresponds to the water-reserving portion (300 in FIG. 1(a)), there is no suggestion that combining the two structures will provide post-shaped members provided consecutively at identical positions in a top plan view from a portion where an external force loaded on said planting portion is directly received (the bottom 202 of the planting portion 200), as in the present invention.

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In other words, there is no suggestion that combining the teachings of these references will produce identical alignments of the independent pillar members 6 of Yoshida et al. and the plural downward cylinders 117 of Furukawa.

The examiner responds:

As best can be understood from the teaching of Furusawa '851, the plant cultivation box and the water reserving box are separate structures for the growth of vegetables.

It is submitted that it would have been within the capability of one of ordinary skill in the art, to have considered growing alternatives to vegetables in the system of Furusawa; such as turf or other grasses, as a low maintenance alternative, and to have a year round live insulating material.

It is further submitted that it would have been obvious to consult the prior art for alternative systems to that effect, for growing sod on a roof or inclined surface, or pavement as claimed; and one of ordinary skill in the art presented with the teaching of Yoshida '285 and Furukawa '661 for instance, could adapt or improve upon the system of Furusawa via those teachings.

As to the contention that the combination of Yoshida '285 and Furukawa '661 would not produce identical alignment as argued, it is respectfully submitted that claim-1 does not appear to recite that limitation as argued.

It is further submitted that Yoshida '285 teaches a plant-cultivable planting **portion** of a general box shape on a water-reserving **portion** of a general box shape as broadly claimed. That is, the claim language does not serve to distinguish a single box from two separate boxes. Further, the post-shaped members (5) in combination with the receiving members (7) are readable on the claimed post positioning and functionality as broadly claimed. Thus, an anticipation rejection could have been made in lieu of the obviousness rejection submitted in the prior office action.

Applicant is urged to amend the independent claim to make clear that the instant invention comprises (or consists) two boxes, wherein the upper planting box consists of a base having four upstanding walls and coextending post-shaped members disposed upwards from the base and downward from the base, in language consistent with figure-1 of the instant invention; and having made that consideration, further distinguish over the prior art such as taught by Nakamura '892 for instance, which teaches in figures 5 and 6, a planting box (10') on a water-reserving box (10), whereby aligned post-shaped members (14) and (15) are evident.

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As to the unexpected benefits as argued, it is respectfully submitted that Furusawa as modified is likewise capable of those stated benefits.

In consideration of the above discussion, the rejections made in the previous office action are maintained and repeated herein this final office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a),
as being unpatentable over **Furusawa** (JP 405284851A) 1993,
in view of **Yoshida** (US 6,237,285) 2001 and
Furukawa (US 5,373,661) 1994.

Regarding **claim-1**:

Furusawa '851 teaches a greening structure (see figures) comprising a plant-cultivable planting portion (4) on a water-reserving portion (7) and laid on a pavement (3) for forming a greening area;

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Furusawa is silent however as to post-shaped members provided as claimed (substantially consecutively from a portion where an external force loaded on said planting portion is directly received, to the bottom of said water-reserving portion or to said pavement, so that said external force is received on said pavement through said post-shaped members).

Furukawa '661 teaches drainage unit boxes in figures 1-8 for use on a roof (pavement as claimed) and **Yoshida '285** teaches a planting box to be spread over the surface of a roof (col.-1, line-53 thereabout) or artificial ground (Abstract).

It is submitted that since Furusawa '851 which, predates both Furukawa '661 and Yoshida '285, teaches a planting portion (4) on a water-reserving portion (7); it would have been within the technical grasp of one of ordinary skill in the art at the time the invention was made, to have combined the plant cultivation portion (figure-7) of Yoshida '285 with the water drainage portion (figure-5) of Furukawa '661 to effect a greening structure as taught by Furusawa '851, and further to have modified the water drainage portion (figure-5) of Furukawa '661 as taught by Furusawa '851 so as to retain moisture for the plant cultivation portion as taught by Furusawa '851: as where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a).

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Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly, applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

Accordingly, since the applicant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Resultantly, the combination of Yoshida '285 and Furukawa '661 as taught by Furusawa '851 would have been obvious to one of ordinary skill in the art at the time the invention was made, and as such the combination would be capable of the force loading recitation as claimed.

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Regarding **claim-2**:

The discussion above regarding claim-1 is relied upon.

It is submitted that the combination of Yoshida '285 and Furukawa '661 as modified is readable on, the first post shaped members disposed upwards from the bottom of the planting portion (Yoshida '285; figure-7) and the second post-shaped members (Furukawa '661) disposed downward from the bottom of the planting portion as claimed, as either Yoshida resting on Furukawa or an integration of the two would be readable thereon the disposition of the post-shaped members as claimed.

Regarding **claim-3**:

The discussion above regarding claim-2 is relied upon.

Furukawa '661 teaches receiving holes (125) for the post-shaped members (117) as claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period,

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then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on 571-272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Francis T. Palo/
Primary Examiner
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